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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,637	04/07/2004	Martin Debreczeny	TYHC:0041/FLE (P0396R)	8831

52144 7590 10/16/2008  
NELLCOR PURITAN BENNETT LLC  
ATTN: IP LEGAL  
60 Middletown Avenue  
North Haven, CT 06473

EXAMINER
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WINAKUR, ERIC FRANK

ART UNIT	PAPER NUMBER
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3768

MAIL DATE	DELIVERY MODE
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10/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,637	<b>Applicant(s)</b> DEBRECZENY, MARTIN	
	<b>Examiner</b> Eric F. Winakur	<b>Art Unit</b> 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

2. The rejection of claims 1 - 4 and 13 under 35 U.S.C. 102(b) as being anticipated by Reynolds is hereby maintained for the reasons of record.

#### ***Claim Rejections - 35 USC § 103***

3. The rejection of claims 5 - 9, 11 - 16, and 18 - 20 under 35 U.S.C. 103(a) as being unpatentable over Vari et al. in view of Reynolds is hereby maintained for the reasons of record.

4. The rejection of claims 10 and 17 are under 35 U.S.C. 103(a) as being unpatentable over Vari et al. and Reynolds as applied to claims 5 and 15 above, and further in view of Jeffcoat is hereby maintained for the reasons of record.

#### ***Response to Arguments***

5. Applicant's arguments filed 24 June 2008 have been fully considered but they are not persuasive. With regard to the rejections under 35 USC 102(b), Applicant contends that contrary to Examiner's position in the previous response, the recitation of a "physiological sensor" in the preamble of independent claims 1 and 13 and the phrase "to enable measurement of a physiological parameter" in the body of the claims are directed to features that structurally distinguish over Reynolds. While Applicant is correct that the claims are directed to a "sensor" there is no claimed element that can do any measurement and as such the only claimed elements of the so-called "sensor"

Art Unit: 3768

are directed to a light source arrangement. When all of the elements of a claim are disclosed by the prior art, the prior art reference is considered to meet the claim. It is noted that in contrast to the "sensor" of claims 1 and 13, the arrangements of the other independent claims of the instant application include at least one element to detect optical signals, thus indicating that Applicant was aware of the necessary elements for sensing, but opted not to positively claim such an element in claims 1 and 13. As such, as mentioned above, the claimed elements define the invention as a light source and mixing element without requiring a sensing/detecting element, and such elements are found in Reynolds. Thus, one must necessarily conclude that the "sensor" of claims 1 and 13 does not structurally define over that of Reynolds.

With regard to Applicant's arguments concerning the combination of Vari et al. and Reynolds or Vari et al., Reynolds, and Jeffcoat, Applicant contends that Reynolds is non-analogous art, and therefore should be removed from consideration and further contends that even if Reynolds were available as art, there was no proper *prima facie* case of obviousness set forth in making the combination of Vari et al. and Reynolds. With regard to Applicant's first point, Applicant contends that since Reynolds is a lighting system for color photography it is not in the field of Applicant's endeavor and notes that one must then decide if it is reasonably pertinent to the particular problem with which the inventor was involved. Applicant presents a narrow view of the problem to be addressed, namely that the invention is related to "homogenizing electromagnetic energy output from a medical sensor to a tissue location for the purpose of measuring a physiological parameter". While this is perhaps the narrowest possible view of the

Art Unit: 3768

problem at hand, Applicant's narrow view is not consistent with recent case law, see in particular, *In re ICON* [83 USPQ2d 1746]. Rather, consistent with this ruling, one of skill in the art would look to other teachings involved in addressing homogenizing electromagnetic energy output from light sources for all purposes, since the problems encountered when attempting to homogenize the light would be little affected by where the light was ultimately to be directed (photographic, physiological measurement situations), but rather would be much more dependent on common aspects (details of the optical fibers, differences in the light sources, etc). As such, when the problem to be addressed is properly viewed as "homogenizing electromagnetic energy that has been transmitted through optical fibers" one must conclude that the teaching of Reynolds is reasonably pertinent to the problem with which the inventor was involved.

As Reynolds has been shown to be analogous art, Applicant's second consideration must also be addressed. First, it must be noted that on page 17 of Applicant's arguments, a quotation from the prior Office action is provided regarding the lack of certain teachings in the prior art, and Applicant concludes that the quoted portion is an incorrect application of established legal precedent. However, Examiner was merely responding to a statement Applicant had made in their prior response. Taken in that context, it is clear that Examiner was not engaging in an incorrect application of legal precedent, but was merely presenting a rebuttal to an argument of Applicant. Applicant notes that Examiner's position is that Vari et al. and Reynolds are presented as teaching alternate solutions to the homogeneity problem. Applicant contends that "because there is not a problem in one reference, it is not reasonable to seek an

Art Unit: 3768

alternate solution from another reference" yet it is well established that substitution of alternate equivalent expedients (yielding a predictable result) is a valid *prima facie* showing of obviousness. Contrary to Applicant's arguments, Examiner has established good and sufficient reasons for the combination, and thus the combination is proper and the rejections are hereby maintained.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F. Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571/272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3768

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric F Winakur/  
Primary Examiner, Art Unit 3768